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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/511,443      | 02/23/2000  | Megumi Kamimura      | 21778.04100         | 3313             |

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EXAMINER

TRAN, THAI Q

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2615

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/511,443

Applicant(s)

KAMIMURA, MEGUMI

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robell et al (WO 98/48532) in view of Chan et al (US 6,711,631 B1).

Regarding claim 1, Robell et al, as discussed in the last Office Action, discloses a method of creating contents (Fig. 1) comprising the steps of:

inputting (74 and 76 of Fig. 1, page 5, lines 19-21) first contents information concerning an audio input source or a video input source or an audio and video source;

compressing a signal of said input source according to the need (78 and 70 of Fig. 1, page 5, lines 21-33);

recording a compressed signal of said input source on a recording medium 20 and 22 of Fig. 1, page 4, line 29 to page 5, line 2);

designating recording position information useful for recording the compressed signal of said input source on said recording medium (page 6, lines 13-30), wherein said recording position information is a starting address of the CD-ROM (a unique

identification number that identifies a computer file containing a compressed recording of the song, page 4, lines 29-35);

creating a table containing at least more than one second contents information concerning a predetermined input source in which said recording position information is added to said first contents information concerning input source (page 4, lines 4-13 and page 6, lines 13-30); and

recording said table on said recording medium (page 6, lines 13-30). However, Robell et al does not specifically disclose the newly added limitation that the recording position information is a starting address of a personal computer card or a DVD RAM or a hard disk drive).

Chan et al teaches that compute 100 permits a user to readily interchange a CD-ROM drive for some other device such as a hard disk drive or conversely (col. 8, lines 11-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the hard disk drive as taught by Chan et al into Robell et al's system in order to increase the storage capacity of the system because hard disk drive has larger storage capacity than CD-ROM.

Regarding claim 2, Robell et al further discloses the claimed wherein said input source signal is compressed in accordance with an MPEG standard (page 5, lines 29-33).

Regarding claim 3, Robell et al discloses the claimed wherein said first contents information contains at least titles of input sources, reproduction times of titles and

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priority information based on the situation in which the input sources had been used (page 4, lines 1-13 and page 6, lines 20-26).

Regarding claim 4, Robell et al discloses the claimed wherein said table is recorded on a starting portion of a recording portion on which the compressed signal of said input source was recorded (page 6, lines 13-30).

Apparatus claims 5-8 are rejected for the same reasons as discussed in method claims 1-4 above.

Recording medium claims 9-12 are rejected for the same reasons as discussed in method claims 1-4 above.

Regarding claim 13, Robell et al, as discussed in the last Office Action, discloses a method of downloading compressed data and a first table from a first recording medium on which compressed data of an audio input source or a video input source of an audio and video input source and said first table indicating first contents information containing reproducing position information concerning said input source are recorded on a second recording medium (Fig. 1), a method of downloading contents comprising the steps of:

downloading said first table from said first table (page 4, lines 1-13 and page 6, lines 13-26);

reading out compressed data of a predetermined input source from said first recording medium based on the reproducing position information of said first contents information concerning a predetermined input source on said first table and downloading the compressed data thus read to said second recording medium (page 6,

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lines 3-30), wherein said recording position information is a starting address of a CD-ROM (the play list comprises a series of data including the version number of the program being operated, an ID number of the CD-ROM, a title of the CD-ROM, the number of audio programs stored on the CD-ROM, the number of compressed audio files that are stored on the CD-ROM, page 7, lines 17-27);

memorizing recording position information useful for recording said compressed data on said second recording medium (page 4, lines 1-13 and page 6, lines 3-30);

creating a second table containing at least more than one second contents information in which reproducing position information in said first contents information concerning said predetermined input information is replaced with recording position information useful for recording on said second recording medium (page 4, lines 1-13 and page 6, lines 13-26); and

recording said second table on a second recording medium (page 6, lines 13-26). However, Robell et al does not specifically disclose the newly added limitation that the recording position information is a starting address of a personal computer card or a DVD RAM or a hard disk drive).

Chan et al teaches that compute 100 permits a user to readily interchange a CD-ROM drive for some other device such as a hard disk drive or conversely (col. 8, lines 11-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the hard disk drive as taught by Chan et al into Robell et al's

system in order to increase the storage capacity of the system because hard disk drive has larger storage capacity than CD-ROM.

Claims 14-16 are rejected for the same reasons as discussed in claims 2-4 above.

Apparatus claims 17-20 are rejected for the same reasons as discussed in claims 13-16.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ

  
THE TRAM  
PRIMARY EXAMINER